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In re application of: Renee Frengut

Serial No. 09/825,269

Filed: April 3, 2001


For: METHOD FOR PROVIDING CUSTOMIZED USER INTERFACE AND TARGETED  
MARKETING FORUM



I HEREBY CERTIFY that the following correspondence: APPELLANT'S BRIEF IN ACCORDANCE WITH 37 C.F.R. 41.37(c) IN TRIPLICATE and RETURN POSTCARD for confirmation of receipt is being deposited with the United States Postal Service, as First Class Mail, with sufficient postage, addressed to Mail Stop PATENT APPEALS AND INTERFERENCES, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on this 17<sup>th</sup> day of April, 2005.

I HEREBY DECLARE that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of : RENEE FRENGUT  
Serial No. : 09/825,269  
Filed : April 3, 2001  
For : METHOD FOR PROVIDING  
CUSTOMIZED USER INTERFACE AND  
TARGETED MARKETING FORUM  
Examiner : Donald Champagne  
Art Unit : 3622  
Our File No. : 1017.8003



**APPELLANTS' BRIEF IN ACCORDANCE WITH 37 C.F.R. §41.37(c)**

Appeal from the Examiner,  
Donald Champagne, in and for  
the United States Patent and Trademark Office

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**I. REAL PARTY IN INTEREST**

The party named in the caption, namely, Renee Frengut, the inventor has assigned the application subject to this appeal to EQUALITATIVE RESEARCH, INC., who is the real party in interest, i.e. the owner at the time the brief is being filed.

**II. RELATED APPEALS AND INTERFERENCES**

Applicant/Appellant and Appellant's legal representative, are unaware of any other appeal(s) or interference(s) which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**III. STATUS OF CLAIMS**

Claims 1-30 are pending in this application and currently stand rejected. Applicant is appealing the rejection of these claims. The appealed claims are set forth in Appendix A to this Brief.

**IV. STATUS OF AMENDMENTS**

No Amendments after Final have been filed.

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

The present invention provides a consumer with a network interface tailored in appearance and content to the consumer's specifications. Page 3, lines 1-2. The invention also provides advertisers and other commercial entities with a targeted audience of consumers that increasing the likelihood of interest in an advertisement or commercial content. Page 3, lines 2-5. The customized interface is achieved by generating a computer file or "page" based on information about the user and the advertisement. Page 3, lines 10-11.

Information about the user comprises a user profile including any preferences for content or layout of the page. Page 3, lines 11-12. Information about the advertisements comprises an ad

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profile including a description of the ad and optionally a definition of the targeted audience. Page 3, lines 12-14. The user and ad profiles are compared to determine matches based on prescribed parameters that dictate how to relate information between the two profile types. Page 3, lines 14-16. A match is found where the ad is consistent with the user's preferences and customized page is generated which includes the matching ad(s). Page 3, 17-19. The page can be formatted to the user's defined preferences. Page 3, line 19-20. Ads not matching the user's preferences are excluded from the customized page. Page 3, lines 20-22. Thus, users only receive the types of advertisements they want. Page 5, lines 15-16.

To create the user profile, the user provides a variety of information about his/her preferences for the custom page and the information the user would like to receive. Page 5, lines 18-19. This user provided information is stored in a user profile database. Page 5, lines 19-20. Thus, when a user accesses a system, such as the Internet, a customized web page is provided as an interface, which contain selected information, advertisements and hyperlinks customized to the user provided profiles and the provided ad profiles. Page 6, lines 9-10.

#### **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

1. Whether claims 1-30 are properly rejected under 35 U.S.C. §112, first paragraph and the specification objected to by the addition of three lines in the claims which provide characteristics concerning the about wording "user profile".

2. Whether claims 1-3 and 6-30 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over Gerace.

3. Whether claims 4 and 5 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over Gerace in view of

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Tuzhilin.

**VII. ARGUMENT**

**A. GROUND OF REJECTION NO. 1**

1. Whether claims 1-30 are properly rejected under 35 U.S.C. §112, first paragraph and the specification objected to by the addition of three lines in the claims which provide characteristics concerning the wording "user profile".

The Examiner has objected to the specification and rejected claims 1-30 under Section 112, first paragraph, alleging "new matter" by Applicant through the addition of the following wording to the claims:

"wherein each user personally assists in the creation of his or her user profile by knowingly inputting the information and are aware that the information will be used to create a customized interface for each user profile".

Applicant respectfully disagrees with the Examiner's position. The above quoted language merely indicates the user knows that the information he or she is inputs is used to create the user's user profile. Thus, by knowingly inputting the information the user is personally assisting in the creation of the user profile. The user also knows that the preferences the user provides to create his or her user profile will be used to create a customized interface for the user. Nothing new is being added to Applicant's specification or disclosure.

Furthermore, upon reading Applicant's application, one having ordinary skill in the art, would immediately recognize that the user personally assists in the creation of his or her user profile, that the user knowingly inputs the information (his or her preferences) and that such information is used to create

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the customized interface for the user.

At page 5, lines 9-20, it is indicated that customized interface is provided to a user. It is also indicated that when the user subscribes, he or she provides (intentional act by the user) a variety of information about his/her preferences for the custom page and the information he/she would like to receive. The intentionally provided information is stored in a user profile database. The user is also aware of his or her user profile, since the user can update (change) the profile at a later time (See Figure 1).

The Examiner states that the above quoted addition limits the term "user profile". Applicant respectfully disagrees with this position as well. The above quoted language is not narrowing the "user profile". As fully described in the specification, the user profile is create from information (preferences) entered by the user. The above quoted language merely indicates that the user knowingly enters the information that will be used for the user profile, as opposed a "cookies" situation wherein unbeknownst to the user, his or her online activities are being monitored to create the user, which is the situation with the cited Gerace patent (discussed in further detail below for Issues 2 and 3).

Accordingly, in view of the above, Applicant respectfully traverses the rejections of claims 1-30 under 35 U.S.C. §112, first paragraph and objection to the specification and asks that such rejection and objection be withdrawn.

**B. GROUNDS OF REJECTION NO. 2**

Whether claims 1-3 and 6-30 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over Gerace.

As to claims subject to this Appeal, Claims 1, 6, 9, 12, 16,

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27 and 30 are independent claims. Dependent claim 2 stands or fall with Independent Claim 1. Independent basis for the allowance of claim 3 is provided in the argument. Accordingly, claim 3 does not stand or fall with Independent Claim 1. Dependent claims 7 and 8 stand or fall with Independent Claim 6. Dependent claims 10 and 11 stand or fall with Independent Claim 9. Dependent claim 15 stands or fall with Independent Claim 12. Independent basis for the allowance of claims 13 and 14 are provided in the argument. Accordingly, claims 13 and 14 do not stand or fall with Independent Claim 12. Dependent claims 17 through 26 stand or fall with Independent Claim 16. Dependent claims 28 and 29 stand or fall with Independent Claim 27.

**Claims 1-3 and 6-30**

Before specifically addressing the Gerace reference, Applicant respectfully notes that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959). Applicant respectfully submits that this is precisely is occurring by the Examiner taking a reference (Gerace) that uses "cookies" to monitor a user's online activities unbeknownst to the user and replace such system with a system (Applicant's invention) that requires the user to knowingly provide his or her preferences for the user profile.

The appealed independent claims indicate that a user profile is created from information intentionally inputted by the user and transmitted to the computer associated with the ad profiles and user profiles. As the user inputs the information, the user knowingly and intentionally dictates what ads will be included on



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the user's interface (Dependent Claim 3). If an ad profile does not match the user profile created from the information inputted by the user, then the ad associated with the ad profile will not appear on the user's interface. Thus, the user's interface includes ads the corresponding to subject matter that the user has knowingly requested. Accordingly, in a sense the user is given a stamp of approval for certain types of advertisements prior to receiving the advertisements. Gerace does not provide advertisements based on preferences knowingly provided by the user. Unknown to the user, the ads provided by Gerace are determined from the user's online activities that are being monitored through "cookies". The user does not know his or her activities are being monitored or will be used to create a customized interface.

Thus, the Gerace patent fails to create user profiles based on information inputted by a user and also fails to teach of a system or method whereby the user is an active part of determining what advertisements will be displayed or sent to the user. Rather the Gerace patent monitors the activity of the user on the Internet without the user's consent or awareness of the ongoing monitoring activity by the Gerace system. Gerace uses this monitoring to predict what types of advertisements the user would like to have sent to the user's computer. Gerace uses what is commonly referred to as "cookies." No preapproval for certain advertisements by the user is provided by Gerace. Additionally, the teachings of the Gerace invention would be destroyed by substituting the "cookies" user activity tracking method which has no intentional user input in contrast to Applicant's unique claimed invention, where the user knowingly provides his or her preferences for use in creating the user's customized interface.

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Additionally, depending on the type of online activity the user performs, such user may not want a customized interface based on the subject matter of his or her online activity (i.e. where the user frequently visits pornographic websites, sensitive information websites such as Alcoholic Anonymous, etc.). Applicant's invention provides a customized interface based on information and advertisements requested by the user. Gerace's invention does not necessarily provide a customized interface that the user will want, be happy with or even contain information or advertisements that the user would have requested had the user been specifically asked.

The Examiner acknowledges that Gerace does not teach of the user personally assisting in the creation of his or her user profile by knowingly inputting the information. This recognized difference between Applicant's invention and Gerace fundamentally distinguishes the two from each other. The Examiner also acknowledges that the user of the Gerace invention is unaware that the information is used to create a customized interface for the user profile, which again is a significant difference between Gerace and Applicant's invention.

The Examiner's position stating that it would be obvious to have users input their personal information clearly destroys the entire teaching of the Gerace invention as it would eliminate the need for the use of "cookies" to create the Gerace customized interface. If the Gerace invention maintained its use of "cookies," then it would be redundant to have the user enter profile information, which could also contradict the information contained from the "cookies."

Furthermore, the Examiner's proposed modification to Gerace, would also prevent Gerace from obtaining its desired information

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unbeknownst to the user, which could effect how the user acts while online. If the user knows he or she is being monitored or intentionally provides the information for creating the customized interface, the user's online activity may significantly differ from where the user is unaware that he or she is being monitored.

**Additional argument specific to claims 13 and 14**

As to claims 13 and 14, there is absolutely no teaching in Gerace for having a user define the amount or percentage of space for the ads.

**Additional argument specific to claim 3**

As to claim 3, as mentioned above, Gerace fails to provide any teaching or suggestion for creating a user profile based on information knowingly provided by the user.

With respect to claims (1-3 and 6-30), there is absolutely no teaching, suggestion or motivation in Gerace for the Examiner's significant modification to the fundamental basis of the Gerace patent. For this reason, as well as others, Applicant respectfully does not believe that Applicant's invention is obvious in view of Gerace and Applicant respectfully asks that the Examiner's rejection be reversed.

As shown above, a motivation, teaching or suggestion for the claimed invention is not found in the Gerace reference. Accordingly, Applicant respectfully traverses the Examiner's rejection of claims 1-3 and 6-30 under 35 U.S.C. §103(a) as being unpatentable over Gerace. Applicant/Appellant respectfully asks the Board to reverse the Examiner's rejection of claims 1-3 and 6-30.

**C. GROUNDS OF REJECTION NO. 3**

Whether claims 4 and 5 are properly rejected under 35 U.S.C.

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§103(a) as being unpatentable over Gerace in view of Tuzhilin.

Independent basis for the allowance of claims 4 and 5 are provided in this argument. Accordingly, claims 4 and 5 do not stand or fall with Independent Claim 1.

Some of the deficiencies of Gerace have been discussed above and also apply to the rejection of the claims discussed in Grounds of Rejection No. 3. Tuzhilin fails to correct these deficiencies. Applicant respectfully submits that the Tuzhilin reference fails to correct the deficiencies noted above for Gerace. Tuzhilin does not provide the teaching, suggestion or motivation for drastically changing the entire operation of how Gerace obtains the user information for creating a customized home page.

The Examiner has stated that Tuzhilin teaches that the user profile defines one or more favorite brands, which reads on advertisers or favorite products. Even if this interpretation is correct, Tuzhilin fails to overcome the fundamental differences of how the user profile is created in Gerace as compared to Applicant's invention. Accordingly, the proposed combination of Gerace and Tuzhilin still fails to teach applicant's unique invention, as now claimed.

Thus, the preceding paragraphs provides separate patentable basis for claims 4 and 5.

Accordingly, Applicant respectfully traverses the Examiner's rejection of claims 4 and 5 under 35 U.S.C. §103(a) as being unpatentable over Gerace in view of Tuzhilin. Thus, Applicant/Appellant respectfully asks the Board to reverse the Examiner's rejection of claims 4 and 5 under 35 U.S.C. §103(a).

In view of the above arguments, Applicant/Appellant respectfully submits that Claims 1-30 are properly allowable over the references relied upon by the Examiner for the rejections.


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WHEREFORE, Applicant respectfully submits that the appealed claims are allowable over the prior art of record and Applicant respectfully requests the Board to reverse the Examiner's final rejections, and pass this case to allowance.

Any additional charges, including Extensions of Time, please bill our Deposit Account No. 503180.

Respectfully submitted,

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## VIII. CLAIMS APPENDIX

1. A method for generating a customized interface, comprising the steps of:

associating in a computer one or more ads with respective ad profiles;

associating in a computer one or more user profiles with each user profile created from information inputted by a corresponding user and transmitted to the computer, wherein each user personally assists in the creation of his or her user profile by knowingly inputting the information and are aware that the information will be used to create a customized interface for each user profile,

determining matching ad profiles by comparing the ad profiles with user profiles for matches; and

selectively including in the interface of a user at least one of the one or more ads associated with the ad profiles matching a user profile associated with the user.

2. The method of claim 1, further comprising the step of excluding from the interface any ads associated with an ad profile not matching the user profile.

3. The method of claim 1, wherein the user profile for each user is created from and solely based on information knowingly provided by each user.

4. The method of claim 1, further comprising the step of including in the interface ads that are related to one or more favorite category of products or services specified in the information provided by the user to create his or her user profile.

5. The method of claim 1, wherein the user profile defines a list of one or more advertisers, the method further comprising the step of including in the interface only those ads that are associated with the advertisers listed in the user profile.

6. A method for generating a customized interface,

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comprising the steps of:

associating in a computer one or more ads with each ad having a respective ad profile;

associating in a computer one or more user profiles with each user profile created from information inputted by a corresponding user and transmitted to the computer, wherein each user personally assists in the creation of his or her user profile by knowingly inputting the information and are aware that the information will be used to create a customized interface for each user profile,

determining matching ad profiles by comparing the ad profiles with user profiles for matches;

storing statistical data determined according to the matches; and

selectively including in the interface of a user at least one of the one or more ads associated with the ad profiles matching a user profile created from the information provided by the user.

7. The method of claim 6, further comprising the step of selecting ads for inclusion in the interface in accordance with the statistical data.

8. The method of claim 6, further comprising the step of charging an advertiser of the ads having a matching profile in accordance with the statistical data.

9. A method for generating a customized interface, comprising the steps of:

associating in a computer one or more ads with each ad having a respective ad profiles;

associating in a computer one or more user profiles with each user profile created from information inputted by a corresponding user and transmitted to the computer, wherein each

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user personally assists in the creation of his or her user profile by knowingly inputting the information and are aware that the information will be used to create a customized interface for each user profile,

determining matching ad profiles by comparing the ad profiles with user profiles for matches;

selectively including in the interface of a user at least one of the one or more ads associated with the ad profiles matching a user profile created from the information provided by the user; and

charging an advertiser of the ads having a matching profile in accordance with the matches.

10. The method of claim 9, wherein the charging step comprises charging the advertiser in accordance with the number of users having matching user profiles.

11. The method of claim 9, wherein the charging step comprises charging the advertiser as a function of amount of space available for presenting the ad to the users.

12. A method for generating a customized interface, comprising the steps of:

associating in a computer one or more ads with each ad having a respective ad profiles;

associating in a computer one or more user profiles with each user profile created from information inputted by a corresponding user and transmitted to the computer, wherein each user personally assists in the creation of his or her user profile by knowingly inputting the information and are aware that the information will be used to create a customized interface for each user profile,

determining matching ad profiles by comparing the ad profiles with user profiles for matches;



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selectively including in the interface of a user at least one of the one or more ads associated with the ad profiles matching a user profile created from the information provided by the user; and

formatting the interface in accordance with the user profile.

13. The method of claim 12, wherein the user profile defines an amount of space on the interface, the method further comprising the step of formatting the interface such that the one or more ads included in the interface are restricted to the amount of space defined in the user profile.

14. The method of claim 12, wherein the user profile defines an percentage of space on the interface, the method further comprising the step of formatting the interface such that the one or more ads included in the interface occupy no more space than the percentage defined in the user profile.

15. The method of claim 12, wherein the user profile defines a framework, the method further comprising the step of formatting the interface in accordance with the framework defined in the user profile.

16. A method for providing a customized interface to a user comprising the steps of:

associating in a computer one or more ads with each ad having a respective ad profiles;

associating in a computer one or more user profiles with each user profile created from information inputted by a corresponding user and transmitted to the computer, wherein each user personally assists in the creation of his or her user profile by knowingly inputting the information and are aware that the information will be used to create a customized interface for each user profile,

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determining matching ad profiles by comparing the ad profiles with user profiles for matches;

selectively including in the interface of a user at least one of the one or more ads associated with the ad profiles matching a user profile created from the information provided by the user; and

repeating the preceding steps each time the user accesses the interface or edits the information inputted to create the user profile.

17. The method of claim 16 further comprising the step of excluding from the interface any ads associated with an ad profile not matching the user profile.

18. The method of claim 16, further comprising the step of generating the interface in real time.

19. The method of claim 16, wherein the providing step further comprises the step of providing the interface to the user in response to and contemporaneously with the creation of the user profile from the information provided by the user.

20. The method of claim 16, further comprising the step of storing statistical data determined according to the user's activity at the interface.

21. The method of claim 20, further comprising the step of charging an advertiser of the ads having a matching profile in accordance with the statistical data.

22. The method of claim 16, further comprising the step of charging an advertiser of the ads having a matching profile in accordance with the matches.

23. The method of claim 22, wherein the charging step comprises charging the advertiser in accordance with the number of users having matching user profiles.

24. The method of claim 23, wherein the charging step

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comprises charging the advertiser as a function of amount of space available for presenting the ad to the users.

25. The method of claim 24, wherein the charging step comprises charging the advertiser according to the number of users to whom the ad was sent.

26. The method of claim 25, wherein the charging step comprises charging the advertiser an amount determined according to a function of when the user receives the ad.

27. A method for providing targeted delivery of an ad with a interface to a user comprising the step of:

associating in a computer an ad profile with the ad;

associating in a computer a plurality of user profiles, wherein each user profile corresponding to a user and created from created from information inputted by the corresponding user and transmitted to the computer, wherein each user personally assists in the creation of his or her user profile by knowingly inputting the information and are aware that the information will be used to create a customized interface for each user profile;

determining matching profiles by comparing the ad profile with user profiles for matches;

if a match is determined, including the ad in the interface of a user associated with the matching user profile; and

providing the interface to the user associated with the matching user profile.

28. The method of claim 27, wherein the ad profile contains information about a targeted audience for the ad.

29. The method of claim 27, further comprising the step of including the ad in the interface on condition that the user profile is consistent with the targeted audience and the inclusion of the ad is consistent with the user profile.

30. A method for generating a customized interface,

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comprising the steps of:

associating in a computer one or more ads with respective ad profiles;

associating in a computer one or more users with respective user profiles wherein the users are anonymous, wherein each user profile is generated from information inputted by a corresponding user and transmitted to the computer, wherein each user personally assists in the creation of his or her user profile by knowingly inputting the information and are aware that the information will be used to create a customized interface for each user profile;

determining matching ad profiles by comparing the ad profiles with user profiles for matches within a prescribed parameter;

maintaining statistical data determined according to the matches such that the data is not accessible to unauthorized parties; and

selectively including in the interface the one or more ads associated with the ad profiles matching the user profile within the prescribed parameter,

wherein the selection is based on the statistical data.

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#### **IX. EVIDENCE APPENDIX**

None

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**X. RELATED PROCEEDINGS APPENDIX**

None

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